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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,032	09/20/2001	Alan J. Lang	D-2821CON	6533
7590	07/06/2004		EXAMINER	
Frank J. Uxa Stout, Uxa, Buyan & Mullins, LLP Suite 300 4 Venture Irvine, CA 92618			CHATTOPADHYAY, URMI	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 07/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	3738
	09/960,032 Examiner Urmi Chattopadhyay	LANG, ALAN J.	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 May 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 70-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 70-88 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 September 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on 5/28/04 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on Application No. 09/960,032 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Response to Amendment***

2. The amendment filed 5/28/04 has been entered. Claims 65-69 have been canceled and new claims 70-88 have been added.

### ***Claim Objections***

3. Claim 81 is objected to because of the following informalities: on lines 9-10, it appears that “each of the maximum optical add power” should be changed to --each of the optical add powers-- because the claim sets forth “*an* annular region having *a* maximum optical add power” (italicized for emphasis). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 82-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Each of claims 82-84 recites the limitation "the first optical add power" in lines 1-2.
2. There is insufficient antecedent basis for this limitation in the claims. It appears that "first" in the limitation should be changed to --maximum--, and will so be interpreted for examination purposes.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 70, 72-75 and 81-85 are rejected under 35 U.S.C. 102(e) as being anticipated by Menezes (USPN 6,199,984).

Menezes discloses an intraocular lens with all the elements of claims 70 and 81.

See Figure 1 and Examples 1 and 2 in column 5 for the lens wearer requiring 2.00 diopters for near vision correction and the resulting lens made for the wearer having a maximum add power of 2.00 diopters for near vision correction. Because 2.00 diopters is less than the add power required for full near vision correction in a pseudophakic subject (shown in applicant's Figure 3 as being 3.5 diopters), it is inherent that the lens of Menezes is for use in a mammalian eye that includes a natural lens having a natural accommodative capability. See column 4, lines 46-50 and columns 4-5, lines 63-5 for the combination of first and second surfaces providing a single, unitary, multifocal (column

1, lines 5-6) lens body that is sized and adapted for placement in the mammalian eye as an IOL (column 2, lines 18-19). See Figure 1 and column 2, lines 22-26 for the body having a central zone (distance vision zone) with a baseline optical power providing a mean power for distant vision and a plurality of annular regions (near vision zone and zone of increasing dioptric power connecting the distance and near vision zones) each having an optical add power. The plurality of annular regions includes a region having a first/maximum optical add power for near vision (near vision zone), wherein the first/maximum optical add power has a magnitude so as to provide, in combination with the natural accommodative capability of the natural lens of the eye, enhanced reading vision ability. The lens body further has a second/additional optical add power (mean optical add power of the zone of increasing dioptric power connecting distance and near vision zones) intermediate between the first/maximum optical add power and the baseline optical power. Each of the optical add powers is less than the full optical power required for near reading in a pseudophakic subject.

Claims 72 and 81, see Figure 1 for each of the plurality of annular regions (near vision zone and zone of increasing dioptric power connecting the distance and near vision zones) having a different optical add power.

Claims 73, 74, and 82-84, see Figure 1 for the first/maximum optical add power (of the near vision zone) being 2.00 diopters, which is reduced by *about* the required percentages relative to the optical add power required for near reading in a subject not having a natural lens in place (shown in applicant's Figure 3 as being 3.5 diopters). Additionally, because the second optical add power is intermediate the first/maximum optical add power and the baseline power, each of the different optical add powers is less

than the full optical power required for near reading in a subject not having a natural lens in place.

Claims 75 and 85, see column 4, lines 55-56. Use of the word "may" discloses an embodiment wherein the lens body includes no cylinder correction.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 71, 76-80 and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menezes in view of Portney (USPN 6,197,058 as cited in applicant's IDS).

Menezes discloses an intraocular lens with all the elements of claims 70 and 81, but is silent to the additional limitation of a fixation member coupled to the lens body, as required by claim 71. Portney teaches an IOL with a fixation member in order to attach the IOL to the eye, as shown in Figure 3. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Portney to modify the IOL of Menezes to include a fixation member in order to attach the IOL to the eye. Menezes is also silent to the limitations of the lens and fixation member being adapted to be placed in the anterior and posterior chambers of the eye, as required by claims 76-79 and 86-87. Portney teaches placing the lens and fixation member in these chambers in order for the lens to function as an IOL. See column 3, lines 61-64. It

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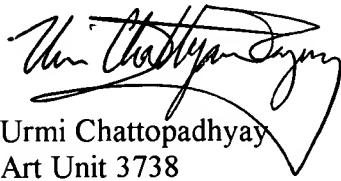
would have been obvious to one of ordinary skill in the art to place the lens and fixation member the anterior and posterior chambers of the eye if the lens of Menezes is to be used as an intraocular lens, as opposed to a contact lens, for example. Portney also teaches the additional limitations required by claims 80 and 88 of the lens being deformable in order to minimize the size of the incision made in the eye for the IOL insertion. See column 3, lines 1-4. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to look to the teachings of Portney to modify the IOL of Menezes to make the lens deformable in order to minimize the size of the incision made in the eye for the IOL insertion.

***Response to Arguments***

10. Applicant's arguments with respect to claims 70-88 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmī Chattpadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 872-9306. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.



Urmī Chattpadhyay  
Art Unit 3738



David J. Isabella  
Primary Examiner